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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 09/928,162 | 08/10/2001 | Mark A. Autry | INTL-0627-US (P12027) | 7312 |
| 7590 | 08/25/2004 | | EXAMINER | |
| Timothy N. Trop TROP, PRUNER & HU, P.C. STE. 100 8554 KATY FWY. HOUSTON, TX 77024-1805 | | | TRUJILLO, JAMES K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2116 | |
| | | | DATE MAILED: 08/25/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/928,162 | AUTRY, MARK A. | |
| | Examiner | Art Unit | |
| | James K. Trujillo | 2116 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. It is hereby acknowledged that the following papers have been received and placed of record in the file: Reconsideration dated 6/17/04.
2. Claims 1-27 are presented for examination.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The rejections are respectfully maintained and reproduced infra for applicant's convenience.
5. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi, U.S. Patent 5,964,873 in view of Firooz et al., U.S. Patent 6,237,091.
6. As to claim 10, Choi substantially teaches a computer system comprising:
 - a. a firmware memory storing an existing basic input/output system image (to-be-updated ROM BIOS) [col. 3 lines 43-53 and figure 4]; and a processor (not shown but inherent for the basic input/output system image to be programmed) to:
 - b. modify a replacement basic input/output system image (with new user information, 113 and 117) by replacing a portion of the replacement basic input/output system image [figures 1A, 1B and col. 3 lines 29-43]; and
 - c. write the modified replacement basic input/output system image to the firmware memory to replace (overwrite the old to-be-updated ROM BIOS image) the existing basic input/output system image [col. 3 lines 43-53].

Choi does not expressly disclose wherein the modification of the replacement basic input/output system image is *with a portion of the existing basic input/output system image* [emphasis added]. Specifically, Choi teaches using input from a user to modify the replacement basic input/output system to implement new user information.

Firooz teaches a system that modifies a replacement (firmware used for update) image with a portion (value from separate portion of memory containing information from the existing firmware) of an existing image (firmware to be updated) [318 figure 3 and col. 1 lines 21-27]. Firooz teaches using firmware images. Basic input/output system images are a type of firmware. Thus, the system of Firooz is similar to that of Choi in that both systems are directed toward updating firmware images. Firooz uses old user data from an existing image while Choi uses new user data. Firooz teaches that when replacing an image in some instances, portions of the existing image need to remain constant to prevent inappropriate operation [col. 2 lines 32-48].

It would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Choi and Firooz before him, to modify the replacement basic input/output system image disclosed by Choi with a portion of the existing basic input/output system image as taught by Firooz, in order to obtain desired previous portions of data such as configuration data. One of ordinary skill in the art would be motivated to make this modification in order preserve a portion of an existing image that has desired previous configuration data as taught by Firooz.

7. As to claim 11, Choi together with Firooz substantially taught the computer system according to claim 10 as described above. Choi together with Firooz further teach that the portion of the existing basic input/output system image comprises configuration data for the

computer system [Choi – col. 2 lines 61-64 and Firooz – col. 2 lines 42-45]. One of ordinary skill in the art would interpret user information to be configuration information.

8. As to claim 12, Choi together with Firooz substantially taught the computer system according to claim 11 as described above. Choi together with Firooz further teach wherein the configuration data comprises boot options [Choi – col. 2 lines 61-64 and Firooz – col. 2 lines 42-45]. One of ordinary skill in the art would interpret user information and configuration information to be boot options for the computer system because in Choi the information is directed to ROM BIOS information. ROM BIOS information is used during booting.

9. As to claim 13, Choi together with Firooz substantially taught the computer system according to claim 10 as described above. Choi together with Firooz teach wherein the portion of the existing basic input/output system image corresponds to a region of firmware memory locked from writes. Choi is directed toward ROM Bios [col. 1 lines 13-18] and Firooz is directed toward firmware in ROM [col. 1 lines 13-23]. Both Bios and firmware in a ROM would normally be write protected as is well known in the art.

10. As to claim 14, Choi together with Firooz substantially taught the computer system according to claim 10 as described above. It is inherent that Choi must contain system memory. Choi is directed toward the ROM Bios for a computer. For a computer to function properly it must use system memory. Choi discloses that the processor stores the replacement basic input/output system image (new ROM BIOS image data) in the system memory [col. 3 lines 14-17].

11. As to claim 15, Choi together with Firooz substantially taught the computer system according to claim 10 as described above. Choi together with Firooz do not expressly disclose

wherein the processor compares the portion of the existing basic input/output system image with the portion of the replacement basic input/output system image to check for compatibility between the existing and replacement basic input/output system images.

Those of ordinary skill in the art would recognize that if portions of images were not compatible they would not function appropriately if one were used to replace the other. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Choi together with Firooz to compare the portion of the existing basic input/output system image with the portion of the replacement basic input/output system image to check for compatibility between the existing and replacement basic input/output system images. Those of ordinary skill in the art would have recognized that if the portions were not compatible the replacement basic input/output system image would not function correctly when the replacement portion is used to replace the existing portion.

12. As to claim 16, Choi together with Firooz substantially taught the computer system according to claim 15 as described above. Choi together with Firooz do not expressly disclose wherein the processor compares the size of the portion of the existing basic input/output system image with the size of the portion of the replacement basic input/output system image.

Those of ordinary skill in the art at the time of the invention would recognize that the portion of the existing basic input/output system image should not be different than the portion of the replacement basic input/output system image. If the existing portion size were different than the replacement portion it would mean that the existing portion was incorrectly copied.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Choi together with Firooz to compare the size of the portion of the existing

basic input/output system image with the size of the portion of the replacement basic input/output system image to determine if the existing portion was copied correctly.

13. As to claim 17, Choi together with Firooz substantially taught the computer system according to claim 15 as described above. Choi together with Firooz do not expressly disclose wherein the processor compares the size of the location of the existing basic input/output system image with the location of the portion of the replacement basic input/output system image.

Those of ordinary skill in the art at the time of the invention would recognize that the portion of the existing basic input/output system image should not be larger than the portion of the replacement basic input/output system image. If the existing portion location were different than the replacement portion it would mean that the existing portion was incorrectly copied.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Choi together with Firooz to compare the location of the portion of the existing basic input/output system image with the location of the portion of the replacement basic input/output system image to determine if the existing portion was copied correctly.

14. As to claim 18, Choi together with Firooz substantially taught the computer system according to claim 10 as described above. Choi teaches wherein the firmware memory comprises FLASH memory [col. 1 lines 21-47].

15. As to claims 1- 9 and 19-27, Choi together with Firooz taught the claimed computer system therefore together they also teach the claimed method and the claimed instructions stored on a computer readable medium.

Response to Arguments

Art Unit: 2116

16. Applicant's arguments filed 17 June 2004 have been fully considered but they are not persuasive.

17. In the remarks, Applicant's argue in substance that Firooz does not mention a basic input/output system image and thus fails to teach or even suggest the missing claim limitations. The examiner agrees with applicants that Firooz does not mention a basic input/output system ("BIOS") image. That is why reference to Choi is relied upon to teach a *BIOS image* that is being replaced, as set forth above an in the previous office action [emphasis added]. Choi only fails to explicitly disclose that a portion of the BIOS is replaced. Firooz teaches a system having firmware wherein a portion of an existing firmware in a flash memory.

BIOS, as those of ordinary skill in the art will appreciate, is a type of firmware. The BIOS of Choi is stored in a flash memory [col. 1 line 30-33]. The system of Firooz is similar to that of Choi. Both systems are directed toward firmware stored in the same type of memory. The firmware of Firooz may also be stored in the same type of flash memory (electrically alterable read-only memory) as Choi [col. 3 lines 33-39]. Those of ordinary skill would recognize that the operation in the flash memory as taught by Firooz would also apply to the flash memory of Choi.

Firooz teaches that when replacing an image in some instances, portions of the existing image need to remain constant to prevent inappropriate operation [col. 2 lines 32-48]. As set forth hereinabove it would have been obvious to one of ordinary skill to make the modification to the BIOS of Choi in order keep a portion of his BIOS image constant to prevent inappropriate operation as taught by Firooz.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James K. Trujillo whose telephone number is (703) 308-6291 [new phone number may be in effect in mid October - (571) 272-3677]. The examiner can normally be reached on M-F (7:30 am - 5:00 pm) First Friday Off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (703)308-1159 [new phone number may be in effect in mid October - (571) 272-3670]. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2116

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Trujillo
August 20, 2004


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